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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/576,992	05/24/2000	Vincenzo Arcella	108910-00006	4767

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EXAMINER

FORTUNA, ANA M

ART UNIT

PAPER NUMBER

1723

DATE MAILED: 07/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/576,992

Applicant(s)

Arcella

Examiner

Ana Fortuna

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 9, 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-23 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1 and 3-23 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

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DETAILED ACTION

Continued Examination Under 37 CAR 1.114

1. A request for continued examination under 37 CAR 1.114, including the fee set forth in 37 CAR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CAR 1.114, and the fee set forth in 37 CAR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CAR 1.114. Applicant's submission filed on 4/09/03 has been entered.

Claim Rejections - 35 U.S.C. § 112

2. Claim 1 recites the limitation ""the distribution maximum peak" in line 4. There is insufficient antecedent basis for this limitation in the claim. The claim should be amended to include after "5-500 nm", in line 2, by inserting "an average pore size distribution", and in line 4, before "distribution", inserting "pore", to refer back to the pore distribution.
3. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as"

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and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims.

Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

In the present instance, claims 8-10, recites the broad recitation "viscosity in the range 5-5000 cp"; "time being from 1 to 10 days"; "boiling temperature in the range of 50-300 degree C" and polymer concentration in the range of "1-20 by weight" respectively, and the claims also recites "preferably 10-300 cp", "3-6 days", "50-150 degree C", "1-10 %" respectively, which is the narrower statement of the range/limitation.

4. ***Allowable Subject Matter***

Claims 1, 3-23 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Reasons for allowance: claims 1, 8-10, and dependent claims, if amended as suggested above, and to correct 112 rejection, will be allowed over the prior art of record. The prior art of record have been reviewed in view of Applicant's arguments and request to consider all the claims together based on the considered critical pore size distribution limitation, and results of membrane performance or table 2 (specification, page 16), and comparative results attached to paper no.17,

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filed on 2/3/03, have also being considered. Additional references newly cited and listed in new form 892, have also been considered. None of the references of record teach membranes made from the polymers claimed, including non-porous and pores, the percent of porosity and the pore size, however, the pore distribution including 80 to 90 % of the pores distributed as claimed with respect to the value of the "pore distribution maximum peak", which interpretation is given to indicated that the majority of the pores are distributed with respect to the larger pores in a + or -5 nm. This distribution is not suggested in the prior art of record.

The membrane in Barnerjee, is selective or specific gases, the membrane of the present invention is shown to be non-selective as argued by Applicant.

Reference 5,032,274 (of record) also teaches porous (Ultrafiltration membranes) made from perfluorinated polymers, a particular pore size distribution with respect to a maximum pore (peak) is not disclosed or suggested.

Since claim 1 was found to be allowable, and the additional claims all depend from claim 1, claims 8-16, directed to the membrane made by a particular process have been rejoined and are also allowed.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana Fortuna whose telephone number is (703) 308-3857. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached on (703) 308-0457. The fax phone number for the organization

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where this application or proceeding is assigned is (703) 872-9310 for regular responses, and
(703)872-9311 for after finals.

Ana Fortuna

June 29, 2003



ANA FORTUNA
PRIMARY EXAMINER